

REMARKS

By this amendment, applicants have amended claim 5 to clarify that the average droplet size is in the range of greater than 100 microns to less than or equal to 500 microns. It is believed this should overcome rejection under 35 USC §112 and it is respectfully requested that this rejection be withdrawn in this regard.

At page 3 of the Office Action, the Examiner continues to reject claims 4-7, 9-13, 15-17, 20 and 22-23 under 35 USC §103(a) as allegedly unpatentable over U.S. Patent No. 6,080,708 (Glenn) in view of U.S. Patent No. 6,395,690 (Tsaur).

Essentially, the Examiner recognizes that Glenn does not disclose the process step of passing oil-in-water pre-dispersion of Glenn through a screen (see page 4, 2nd full paragraph of the Office Action).

In response to applicants' comments that there would be no reason for Glenn to use a screening process, the Examiner states that, because Glenn recognizes size is important factor for lipid deposition and because Tsaur discloses that size of droplets can be controlled by screening technology (number and size onscreen), this would have motivated one of ordinary skill in the art to use the screening method of Tsaur to make the compositions of Glenn. This rejection is respectfully traversed for reasons set forth below.

The process used to make the large oil drop compositions of Tsaur and the compositions of Glenn are completely different and reflect the difference in what they are attempting to achieve.

Thus, for example, in Tsaur the oil or oil/polymer blend is separately mixed and/or injected into the structured liquid cleanser base (separately prepared) to form droplets >100, preferably greater than 200 micrometers (column 3, lines 52-61). The

composition is then passed through screens having opening larger than 30 micrometers, preferably larger than 50 micrometers to form final product.

In Glenn, the lipids are also added to the aqueous phase as a premix of lipid blend (column 17, line 58). In contrast to the large polymer droplets of Tsaur (see column 3, lines 59-61 of Tsaur), however, the size of lipid droplets make the emulsion of Glenn range from 0.1 to 100 microns (column 13, lines 59-60). At least 40% of the droplets are from size 5 to 25 microns (column 13, line 64). An especially preferred droplet size range is said to be:

15-35%	-	0.1 to 5 microns
15-45%	-	5 to 10 microns
30-50%	-	10 to 25 microns
<15%	-	> 25 microns

The lipid drops in the emulsion are formed, as noted, by taking the lipid premix and adding to aqueous phase at 105-110° F (column 17, lines 59-61). The blend is allowed to stir for about 2 minutes at slow/medium setting and, as the Examiner correctly states in the Office Action, the intensity and duration of mixing are “important” with regard to particle size.

However, as noted, adding premix and stirring itself creates a blend with droplet size range noted above. The last thing Glenn wants to do is to make droplets which are even smaller (as this would deleteriously impact deposition).

Given the fact that particles must be controlled to, in effect, not get too small, there is not only no teaching or suggestion to pass composition through screens (i.e., to get even smaller droplets), but there is a teaching away from any means which would reduce droplet size.

In short, the disclosure of a means to reduce droplet size (regardless of what initial and final size are) is a teaching away or disincentive from applying the Tsaur reference to process of Glenn where, if anything, you want to maintain the droplets as large as reasonably possible after mixing lipid blend into aqueous phase.

In this regard, applicants also draw the Examiner's attention to Declaration of Michael P. Aronson mailed with Response to November 4, 2004 Office Action on February 1, 2005 (and of record in the file). In that Declaration, it was pointed out how finely divided particles were used to structure oils of the subject invention (paragraph 9) in contrast to Glenn where trihydroxystearin was in aqueous phase. These structured oils of the subject invention are again of larger size initially where screening reduces size but they are still relatively large. Again, lipids of Glenn are never this large and, as noted, any reference (e.g., Tsaur) teaching reduction would never be combined with Glenn where, as the Examiner recognizes, the "importance" of large size droplets is appreciated.

In view of the remarks above, it is respectfully requested that the Examiner reconsider and withdraw rejections of the claims in view over Glenn in view of Tsaur.

Exactly the same reasoning applies with regard to rejection of claims 19 and 21 under 35 USC §103 over Glenn in view of Tsaur and further in view of Lochhead et al.

Specifically, Lochhead has no screening process step. Since the combination of Glenn and Tsaur fall for reasons noted above, it is irrelevant that Lochhead is employed for its teachings of a process of making composition similar to Glenn without a conventional surfactant (see page 10, 2nd full paragraph of Examiners' Office action).

Accordingly, it is also respectfully requested that this rejection be withdrawn.

Finally, although it is believed that the Examiner may be aware of related applications in this area by applicant, applicants forward an Office Action issued in

related application, U.S. Serial No. 11/122,143, which is directed to a method of moisturizing skin using compositions similar to those of the subject invention. A response to the Office action is not due till January 9, 2008 and applicants have not yet responded.

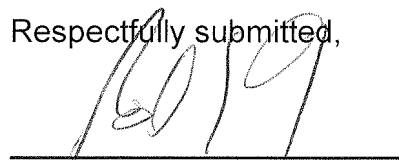
As noted, however, the Examiner has cited the same Glenn et al. reference (which merits a different response to the method claim than to the way it is applied against process claims of subject invention). In addition, the Examiner has issued obvious-type double patenting rejections based on following related cases, now issued:

- (1) U.S. Patent No. 7,192,598;
- (2) U.S. Patent No. 6,923,975; and
- (3) U.S. Patent No. 6,716,440

Applicants are filing this RCE in order to cite these and to hopefully place the case in condition for allowance.

If a telephone conversation would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/122,143	05/04/2005	Michael Paul Aronson	J6700(C)	5087

201 7590 10/09/2007
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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

MAIL DATE	DELIVERY MODE
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10/09/2007

PAPER

RAK.

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

O.A / Term. Disc.

OCT 11 2007
Received
Unilever Patent Dept.
Englewood Cliffs, NJ

Office Action Summary

Application No.

11/122,143

Applicant(s)

ARONSON ET AL.

Examiner

Gina C. Yu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

Claims 12 and 19 are objected to because of the following informalities: in line 2 of these claims, there is a typographical error in reciting "acyl". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11 and 18 limit the base claims with limitations, "further comprising an inorganic dispersion stabilizer". The claims are vague and indefinite because the claimed inventions in claims 1 and 17 are directed to methods, while the limitations of claims 11 and 18 do not properly limit the process. Furthermore, it is not clear in which phase the claimed invention requires the inorganic dispersion stabilizer to be.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn Jr. et al. (US 6080708).

Glenn teaches that the claimed method of moisturizing skin after cleansing by applying a composition comprising emollients and rinsing off is well known in cosmetic art. See col. 1, lines 21 – 41. Glenn teaches a cleansing/moisturizing dual composition which comprises dispersed crystalline hydroxyl-containing stabilizer. The reference teaches that the use of stabilizer such as trihydroxystearin, lipid moisturizing agents in oil-in-water emulsion formulations. See abstract. The viscosity of the composition is within the claimed range. See col. 2, lines 31 – 47; col. 10, line 41- col. 11, line 19. The reference teaches that the use of crystalline, hydroxy-containing stabilizer forms network in the emulsion and prevents the lipophilic skin moisturizing droplets from coalescing and phase separation. See col. 4, lines 26-46. The stabilizers are also said to provide shelf-stability and stress stability. Hydroxy-containing fatty acids, fatty ester or fatty soap water-insoluble wax-like substances can be used. See col. 4, line 46 – col. 5, line 30. See instant claims 8 and 9. The reference further teaches that silica having particle size less than 0.1 microns, amorphous silica, or clay can be used as stabilizer also. See col. 5, line 64 – col. 6, line 54. See instant claims 6 and 7. See col. 11, line 1 – col. 13, line 58 for the suitable lipid for moisturization. The reference also teaches, in a most preferred embodiment, using at least 75 % of the lipid phase petrolatum, blends of petrolatum or microcrystalline wax. See col. 13, lines 3- 20. See instant claim 9. The reference also teaches that it is well known in the art to make liquid skin cleansing product with petrolatum having particle sizes of 10-120 microns. See col. 2, line 4-8.

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The size of the lipid droplets is said to be in the range of 0.1-100 microns. See col. 13, line 58 – col. 14, line 7.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have make the rinse-off composition of Glenn as taught by the reference because of the expectation of successfully producing a dual function moisturizing/cleansing emulsion composition with improved stability. The limitations on the condition of the stability, skin retention efficiency index, and zein solubility are viewed as the resulting measurement of the obvious variation of the prior arts, absent evidence to the contrary.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 10-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 7192598 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed methods are directed to using a composition having limitations that overlap with the claimed composition of the '598 patent. The '598 compositions require specific types of oil and structurants for the oil phase.

Claims 10-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6923975 B2.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to methods of using a composition having limitations that overlap with each other. The '598 compositions require specific particle size of the oil phase and skin irritation potential, while the present invention requires specific types of organic dispersion stabilizers. These organic dispersion stabilizers are defined in the specification of the '975 patent, which would have rendered a skilled artisan obvious to make the present invention. See '975, col. 7, lines 3-45.

Claims 10-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6716440 B2.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to methods of using a composition having limitations that overlap with each other. The '440 compositions require specific particle size of the oil phase skin irritation potential, while the present invention requires specific types of dispersion stabilizers. These stabilizers of the instant claims are defined in the specification of the patent, which would have rendered a skilled artisan obvious to make the present invention. See '440, col. 7, line 41 – col. 8, line 31.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gina C. Yu
Patent Examiner

Notice of References Cited	Application/Control No. 11/122,143	Applicant(s)/Patent Under Reexamination ARONSON ET AL.	
	Examiner Gina C. Yu	Art Unit 1617	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,080,708	06-2000	Glenn et al.	510/130
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.